

arm constitutes a front piece, and wherein the front piece includes appropriate fixing means for fixing the front piece on the rear piece, at the level of the dorsal portion.

B4 19. (Amended) A sports boot according to claim 1, wherein each external lateral arm is furthermore connected to the dorsal portion by a connecting lug oriented substantially along the flexion fold.

20. (Amended) A sports boot according to claim 1, wherein the dorsal portion has a bottom portion that is flared so as to surround the heel.

Please add new claims 29 and 30 as follows:

B5 -- 29. A sports boot according to claim 1, wherein the flexible frame is made of a non-leather material.

30. A sports boot according to claim 29, wherein said material is a polymer. --

#### REMARKS

##### Status of the Claims

Upon entry of the amendment above, claims 1-20, 24-27, 29, and 30 will be pending, claims 1, 2, 13, 14, and 24 being independent. Claims 1-18, 24-27, 29, 30 are "readable" on the elected invention.

**Summary of the Office Action**

Claims 1-15, 18, 24, and 27 are rejected under 35 USC 102(b) as being anticipated by REINHART et al. (U.S. Patent No. 2,261,453, hereinafter "REINHART").

Claims 1-3, 5, 13, 14, and 21-27 are rejected under 35 USC 102(b) as being anticipated by SPIER (U.S. Patent No. 3,807,062).

Claims 1, 2, 4-8, 12-14, 24, and 27 are rejected under 35 USC 102(e) as being anticipated by SAILLET (U.S. Patent No. 5,901,469).

Claims 1-3, 13, and 14 are rejected under 35 USC 102(b) as being anticipated by BROWN (U.S. Patent No. 4,869,001).

Claims 1-18, 24, and 27 are rejected under 35 USC 102(e) as being anticipated by HOSHIZAKI et al. (U.S. Patent No. 5,498,033).

**Response to the Office Action****A. Summary of Amendment**

In the amendment above, the total number of claims has been reduced. Claims 21, 22, 23, and 28 have been canceled.

Upon entry of the amendment above, independent claims 1, 13, and 14 would include, inter alia, the limitation that "the external upper extends above an ankle region to about a middle region of a tibia of the user."

This limitation had previously been recited in dependent claims 21, 22, and 23 and these claims had only been rejected on the basis of SPIER. Therefore, Applicant submits that the amendment to the independent claims 1, 13, and 14 should necessarily be effective to remove from consideration all of the rejections thereof with the exception of SPIER. Further, at least for reasons which will follow, Applicant requests that her rejection based upon SPIER be reconsidered and withdrawn, thereby rendering the claims allowable.

Further, although Applicant submits that independent claim 24 is patentable over the references relied upon in the rejections, if an amendment to claim 24 like that made to independent claims 1, 13, and 14 would advance this application to allowance, Applicant hereby authorizes the Examiner to make an Examiner's Amendment to claim 24 in this regard.

Independent claim 2 has been rewritten in independent form and it has been further amended to recite in more specificity the shape and orientation of the lateral arm(s). Specifically, the lateral arm is recited as being "spaced above the outer sole at the dorsal portion and extending forwardly from the dorsal portion and connected to the outer sole forwardly of the dorsal portion." For example, in the elected embodiment of Figs. 6, 7, as well as in the non-elected embodiment, the lateral arm (reference numeral "15") does not extend around the heel in the manner of certain prior art references, but it is spaced above the sole until it is connected thereto forwardly of the rear of the frame.

Finally, new dependent claims 29 and 30 have been added to make specific reference to the material of which the flexible frame is made.

## **B. Withdrawal of Rejections Under 35 USC 102**

### **1. SPIER**

Applicant kindly requests that the Examiner reconsider and withdraw her rejection of independent claims 1, 13, 14, and 24 over SPIER.

SPIER discloses a boot having an inner shell portion that has a greater rigidity arranged to provide rigidity to the boot where required for the particular athletic activity for which the boot is used. As can be understood from column 2, lines 64-66 of SPIER, the inner shell 21 must be formed of a relatively rigid plastic material to impart strength, stiffness, and rigidity to the boot. This idea is confirmed for the other embodiments from column 4, lines 11-16.

In short, the frame of Applicant's invention is flexible, whereas the inner shell of SPIER is rigid.

As mentioned above, each of independent claims 1, 13, and 14 include the following limitation: "the external upper extends above an ankle region to about a middle region of a tibia of the user." Further, independent claim 24 includes the following limitation: "said flexible frame comprising a dorsal portion extending upwardly above an ankle region at a rear of the lower leg ...."

In contrast, the so-called "frame" of SPIER only extends to the ankle area (see col. 3, ll. 8-21). That is, element 27 of SPIER is an "ankle-covering portion." Further, there would be no apparent reason why one skilled in the art would have been motivated to have modified the SPIER boot in a way that would have resulted in the claimed invention.

Further, in claim 24, Applicant calls for the lateral portion of the frame to be spaced above the external sole and to be connected to the external sole proximate an area of the metatarsophalangeal joint of the user's foot.

Similarly, in claim 2, Applicant has specified that the lateral arm is spaced above the outer sole at the dorsal portion and extends forwardly from the dorsal portion and is connected to the outer sole forwardly of the dorsal portion.

These limitations of claims 2 and 24 are not found in SPIER.

At least for the reasons above, reconsideration and withdrawal of the rejection based upon SPIER is requested.

## **2. REINHART**

First, with regard to REINHART, inasmuch as claims 21, 22, and 23 had not been rejected over REINHART, Applicant submits that the addition of the subject matter of claims 21, 22, and 23 into their respective parent independent claims has effectively overcome the rejection of independent claims 1, 13, 14 over REINHART.

Regarding independent claim 24, Applicant respectfully submits that there is a particular limitation that has not be fairly appreciated, which is believed to differentiate the invention from

REINHART. That is, at the end of the rejection at the top of page 3 of the Office action, the Examiner states "Note the lateral arms 1." In claim 24, Applicant calls for the lateral portion of the frame to be spaced above the external sole and to be connected to the external sole proximate an area of the metatarsophalangeal joint of the user's foot." By contrast, the lateral arms 1 of REINHART end, and are connected to, the upper eyelet of his shoe.

Similarly, in independent claim 2, Applicant has specified that the lateral arm is spaced above the outer sole at the dorsal portion and extends forwardly from the dorsal portion and is connected to the outer sole forwardly of the dorsal portion.

In contrast to the shape of the frame specified in claims 2 and 24, in REINHART, and as explained at page 1, column 2, lines 16-22, of REINHART, the reinforcing device C extends continuously or unbrokenly from the sole of the shoe to the top edge of the upper. REINHART further explains at page 2, column 1, lines 6-11, that the counter-shaped bottom portion of the reinforcing device C embraces or surrounds the heel seat portion of the sole and it projects upwardly a considerable height before merging into the web portion of the member C that extends upwardly at the rear of the shoe upper.

This construction of REINHART means that at least the bottom portion of the reinforcing device C looks like a continuous shell, which surrounds the heel. Of course, such a shell transmits forces along all directions.

Very differently, in Applicant's invention there is a frame which includes arms with holes, whereby the frame does not surround any part of the foot in the way REINHART teaches. This is particularly true in the elected invention shown, e.g., in Figs. 6, 7, on which merely no part of the frame is in front of the rear bottom part of the heel. Of course, such frame transmits forces along predetermined directions, i.e., along the arms.

Although independent claim 24 includes the limitation that the dorsal portion extends upwardly above the ankle region at the rear of the lower leg, if the additional recitation that it

extends upwardly to about a middle region of a tibia would necessarily overcome the rejection based upon REINHART and place the instant application in condition for allowance, the Examiner is hereby authorized to enter an Examiner's Amendment to this effect.

Further regarding the merits of REINHART, the Examiner observes that a frame is disclosed as being made of leather, which the Examiner has characterized as constituting a "flexible, substantially non-stretchable material", oriented in a direction that is pertinent to the invention. Although Applicant submits that the rejected claims are allowable over REINHART at least with for reasons mentioned above, Applicant has added new claims 29 and 30 to specify that the material of the frame is non-leather and, more specifically, a polymer.

At least for the foregoing reasons, reconsideration and withdrawal of the rejection based upon REINHART is requested.

### **3. SAILLET**

First, inasmuch as claims 21, 22, and 23 had not been rejected over SAILLET, Applicant submits that the addition of the subject matter of claims 21, 22, and 23 into their respective parent independent claims has effectively overcome the rejection of independent claims 1, 13, 14 over SAILLET.

Regarding independent claims 2 and 24, Applicant respectfully submits that in view of the particular limitation mentioned above in conjunction with Applicant's comments regarding REINHART, the rejection based upon SAILLET should also be withdrawn.

That is, the lateral arms of the frame of SAILLET are not connected to the sole, i.e., they extend forwardly and end above the sole.

Further, as noted in Applicant's previous response, the frame of SAILLET is rigid, i.e., not flexible.

### **4. BROWN**

Because claims 21, 22, and 23 had not been rejected over BROWN, Applicant submits

that the addition of the subject matter of claims 21, 22, and 23 into their respective parent independent claims has effectively overcome the rejection of independent claims 1, 13, 14 over BROWN.

#### **5. HOSHIZAKI**

Because claims 21, 22, and 23 had not been rejected over HOSHIZAKI, Applicant submits that the addition of the subject matter of claims 21, 22, and 23 into their respective parent independent claims has effectively overcome the rejection of independent claims 1, 13, 14 over HOSHIZAKI.

Regarding independent claims 2 and 24, Applicant respectfully submits that in view of the particular limitation mentioned above in conjunction with Applicant's comments regarding REINHART, the rejection based upon HOSHIZAKI should also be withdrawn.

That is, the lateral arms of the frame of HOSHIZAKI end at a forward end above the sole. Contrary to claim 24, they do not connect to the sole in the area of the metatarsophalangeal joint.

#### **SUMMARY AND CONCLUSION**

The grounds of objection and rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

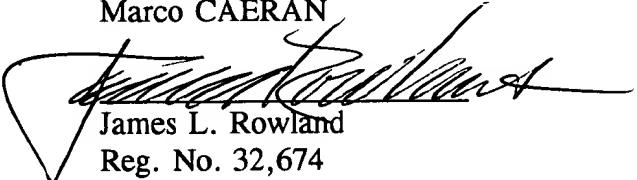
Any amendment to the claims presented above, which has not been specifically noted to overcome a rejection based upon prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach to such amendments.

No fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this response timely and/or complete, Applicant requests an extension of time under 37 CFR 1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR 1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
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**MARKED-UP VERSION OF AMENDMENTS****In the Claims**

Claims 1-7, 13, 14, 16, 18, 19, and 20 are amended as follows:

1. (Twice Amended) A sports boot, especially for gliding sports, comprising:  
an outer sole and an external upper covering a user's foot and lower leg, the external upper comprising a flexible frame made of a flexible, substantially non-stretchable material, arranged along determinate directions of forces transmitted during use of the boot, said flexible frame being affixed to both the external upper and the outer sole, the flexible frame comprising a dorsal portion extending from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot, and at least one lateral arm laterally connecting an upper end of the dorsal portion to one side of the boot.

2. (Amended) A sports boot [according to claim 1, wherein] comprising:  
an outer sole and an external upper covering a user's foot and lower leg, the external upper comprising a flexible frame made of a flexible, substantially non-stretchable material, arranged along determinate directions of forces transmitted during use of the boot, said flexible frame being affixed to both the external upper and the outer sole, the flexible frame comprising [comprises] a dorsal portion extending from the outer sole substantially up to a top end of the external upper, and at least one lateral arm laterally connecting the [upper end of] the dorsal portion to one side of the boot, said lateral arm spaced above the outer sole at the dorsal portion and extending forwardly from the dorsal portion and connected to the outer sole forwardly of the dorsal portion.

3. (Amended) A sports boot according to claim 1 [2], wherein said at least one lateral arm comprises two substantially symmetrical lateral arms.

4. (Amended) A sports boot according to claim 1 [2], wherein each said lateral arm is fixed to the outer sole by a connecting lug, substantially in an area of the metatarsophalangeal joint of the foot.

5. (Amended) A sports boot according to claim 1 [2], wherein at least one lateral arm comprises a tightening arrangement.

6. (Amended) A sports boot according to claim 1 [2], wherein the dorsal portion laterally comprises at least one lug having a tightening arrangement and is on a level with the top of the external upper.

7. (Amended) A sports boot according to claim 1 [2], wherein the dorsal portion laterally comprises two substantially symmetrical lugs.

13. (Twice Amended) A sports boot, especially for gliding sports, comprising an outer sole and an external upper overlying the outer sole and covering a user's foot and lower leg, the external upper comprising a flexible frame made of a substantially non-stretchable material and affixed to the upper and sole, comprising a dorsal portion, extending vertically at the rear of the lower leg, and comprising at least one lateral portion, extending laterally along the foot, connected to said dorsal portion and to the sole, at each of its ends, wherein the external upper extends above an ankle region to about a middle region of a tibia of the user.

✓ 14. (Twice Amended) A sports boot, especially for gliding sports, comprising an outer sole and an external upper overlying the outer sole and covering a user's foot and lower leg, the upper including a flexible frame made of a substantially non-stretchable material and arranged so as to provide a predetermined moment of inertia along predetermined directions, wherein the external upper extends above an ankle region to about a middle region of a tibia of the user.

16. (Amended) A sports boot according to claim 1 [2], wherein the dorsal portion comprises a recess at the level of the front portion of the heel of the foot.

18. (Amended) A sports boot according to claim 1 [2], wherein the dorsal portion constitutes a rear piece, and the dorsal portion including at least one lug, and at least one lateral arm constitutes a front piece, and wherein the front piece includes appropriate fixing means for fixing the front piece on the rear piece, at the level of the dorsal portion.

✓ 19. (Amended) A sports boot according to claim 1 [2], wherein each external lateral arm is furthermore connected to the dorsal portion by a connecting lug oriented substantially along the flexion fold.

✓ 20. (Amended) A sports boot according to claim 1 [2], wherein the dorsal portion has a bottom portion that is flared so as to surround the heel.